REMARKS

In response to the final Office Action dated December 4, 2001, claim 2 has been amended. Therefore, claims 2-23 remain in the case. Reexamination and reconsideration of the application as amended are requested.

A Petition to Correct Inventorship is submitted herewith along with the necessary documents to join three inventors, Steven D. Lamb, Loren K. Imes and Mark E. Hickling, with the originally-named inventor, Benjamin F. Kilgore. The three inventors that are being added were omitted by error and without any deceptive intent.

The Office Action rejected claims 2-6 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as their invention.

In response, the Applicants respectfully traverse this rejection. However, in an effort to further and expedite the prosecution of this application the Applicants have amended claim 2 to more particularly point out and distinctly claim the invention. In particular, amended claim 2 makes even more clear that the query grid is stored on the server as raw data.

In view of the amendments to independent claim 2, the Applicants respectfully submit that the rejection of claim 2 under 35 U.S.C. § 112, second paragraph, as being indefinite has been overcome. Moreover, claims 3-6 depend from independent claim 2 and are also definite. The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 2-6 under 35 U.S.C. § 112, second paragraph.

The Office Action rejected claims 2-23 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. (U.S. Patent No. 6,012,044).

The Applicants respectfully traverse this rejection based on the arguments below.

The Office Action contended that Maggioncalda et al. disclose all elements of the

Applicants' claimed invention except for the interface tool having drop-down menus. However, the Office Action further stated that it would have been obvious to one having ordinary skill in the art to include a drop-down menu as an interface tool to facilitate user interaction with a constrained set of decision variables.

The Applicants respectfully disagree with these statements. It is the Applicants' position that the reference of Maggioncalda et al. is not prior art in relation to Applicants' invention.

In general, as set forth in 37 CFR § 1.131, if a reference does not claim the same patentable invention as the applicant, and the applicant reduced the invention to practice in the United States prior to the effective date of the reference, then the reference is not prior art in relation to the applicant's invention. The Applicants respectfully maintain that these circumstances exist in the subject case.

First, Maggioncalda et al. do not claim the same patentable invention as the Applicants. In accordance with 37 C.F.R. § 1.601(n), the "same patentable invention" is one where an applicant's invention is anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103. The Applicants' claimed invention is not anticipated by Maggioncalda et al. because Maggioncalda et al. lack at least one claimed element of the Applicants' invention. In particular, Maggioncalda et al. lacks the Applicants' claimed element of transmitting associated data (which is a subset of all available data) from a server to the client.

The Applicants' claimed invention also is not obvious under 35 U.S.C. § 103 in view of the Maggioncalda et al. reference. A prima facie showing of obviousness must consider all of the claimed elements of an applicant's invention, especially when these claimed elements are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, if the prior art references do not disclose, suggest or provide any motivation for at least one claimed element of an applicant's

invention then a prima facie case of obviousness has not been established (MPEP § 2142).

Independent claims 2, 7 and 19 of the Applicants' invention include transmitting associated data (which is a subset of all available data) from a server to the client. In contrast, Maggioncalda et al. transmits all data contained on the server to the client computer. Moreover, Maggioncalda et al. fail to appreciate the advantages of transmitting only a subset of all available data. Specifically, transmitting only a portion of all available data reduces transmission and download times and decreases storage space requirements on the remote client.

Accordingly, the Applicants respectfully contend that the independent claims 2, 7 and 19 are nonobvious over the Maggioncalda et al. reference. Further, claims 3-6 depend from independent claim 2, claims 8-18 depend from independent claim 7, and claims 20-23 depend from independent claim 19. It follows, therefore, that these dependent claims are also nonobvious over the Maggioncalda et al. reference (MPEP § 2143.03).

Thus, the Applicants' invention is not the "same patentable invention" as Maggioncalda et al. under 37 C.F.R. § 1.601(n) because the Applicants' invention is neither anticipated by Maggioncalda et al. under 35 U.S.C. § 102 nor obvious in view of Maggioncalda et al. under 35 U.S.C. § 103. Accordingly, the Maggioncalda et al. reference does not claim the same patentable invention as the Applicants' invention.

Second, in order to prove that the Maggioncalda et al. reference is not prior art in relation to the Applicants' invention, it also must be shown that the Applicants reduced the invention to practice in the United States prior to the effective date of the Maggioncalda et al. reference. The effective date of Maggioncalda et al. is the filing date of May 25, 1999. Because Maggioncalda et al. is a continuation of U.S. Patent 5,918,217, however, in certain situations the effective date of Maggioncalda et al. may be the filing date of the parent, or December 10, 1997.

In either case, the Applicants' reduction to practice occurred before the earliest effective date of December 10, 1997 of the Maggioncalda et al. reference. The Applicants reduced the invention to practice at Microsoft Corporation in Redmond, Washington prior to

the earliest effective date of December 10, 1997. This is evidenced by the attached declaration of one of the Applicants and an associated exhibit.

The declaration states the reduction to practice occurred prior to December 10, 1997, and the exhibit supports this statement. The exhibit is an e-mail, dated September 19, 1996, sent by one of the Applicants to other members of a development team indicating that the first release build of a software application entitled "LoanCalc" containing the Applicants' claimed invention was available at an internal Microsoft directory.

Moreover, the declaration signed by one of the Applicants states that the first release build of LoanCalc referred to in the e-mail includes the Applicants' claimed invention. The e-mail along with the declaration proves reduction to practice, and the date of the e-mail proves that reduction to practice occurred at least before December 10, 1997. The date of the e-mail is at least over one year before any of the effective dates of the Maggioncalda et al. reference. Accordingly, the Applicants respectfully submit that they have shown that the required reduction to practice occurred in the United States prior to any effective dates of the Maggioncalda et al. reference.

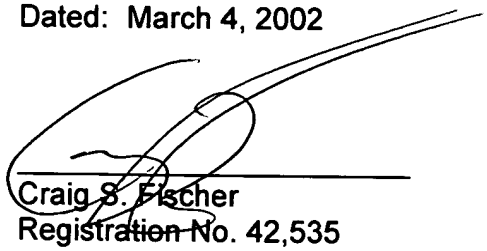
The Applicants have shown that Maggioncalda et al. do not claim the same patentable invention as the Applicants' invention and that the Applicants reduced the invention to practice in the United States prior to any effective date of the Maggioncalda et al. reference. Consequently, the Applicants respectfully submit that the Maggioncalda et al. reference is not prior art in relation to the Applicants' invention. Accordingly, the Applicants' invention is patentable in view of Maggioncalda et al. under 35 U.S.C. § 103(a).

In view of this unavailability of Maggioncalda et al. as prior art, the Applicants respectfully submit that the rejection of claims 2-23 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. has been overcome. The Applicants, therefore, respectfully requests reexamination, reconsideration and withdrawal of the rejection of claims 2-23 under 35 U.S.C. § 103(a).

In view of the arguments set forth above, the Applicants respectfully submit that pending claims 2-23 of the subject application are in immediate condition for allowance. The Examiner

is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invites the Examiner to telephone the Applicants' attorney at (805) 278-8855 if the Examiner has any comments, questions or concerns.

Respectfully submitted,
Dated: March 4, 2002



Craig S. Fischer
Registration No. 42,535
Attorney for Applicants

LYON & HARR, L.L.P.
300 East Esplanade Drive, Suite 800
Oxnard, CA 93030-1274
Telephone: (805) 278-8855
Facsimile: (805) 278-8064

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Following is a marked-up version of amended claim 2:

2. (Thrice Amended) A display device having rendered thereon dynamically changing results of a database query, comprising:

a query grid having at least one field and associated data [and] , the query grid being stored on a server as raw data, wherein the query grid is transmitted from the server to a remote client through a communications interface in response to a communication from the client to the server; and

at least one adjustable interface option displayed on the client display device for adjusting associated data of the at least one associated field in real time using the remote client to process the adjustment.